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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,509	03/05/2002	Franz Rottner	5000.1002	7138

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EXAMINER

SAINT SURIN, JACQUES M

ART UNIT	PAPER NUMBER
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2856

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DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,509

Applicant(s)

ROTTNER ET AL.

Examiner

Jacques M Saint-Surin

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. The preliminary amendment of 03/05/02 has been received and entered as paper # 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-18, 20-24, 26-29, 31 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lach (French Patent 2,578,974).

Regarding claims 17 and 36, Lach discloses a device to detect a state of a component, the device comprising:

a receiver (optical receiver 3, see: Figs. 1-5) disposed on the component (body 1) and having a light-sensitive surface (reflector 8, see: Fig. 5);

a transmitter (transmitter 2, see Figs. 1-4) disposed on the component (1) at a distance from the receiver (3) and configured to emit a beam outside of the component (1) to the receiver (3); and an evaluation unit (circuit detection 5, see: Fig. 3 and page 4, lines 13-15).

Regarding claim 36, as discussed above, it is rejected for the reasons set forth for claim 1. Furthermore, Lach shows in Fig. 5 a clamping element and a plate (support S clamped to the component, see also page 6, lines 2-7 and Fig. 12).

Regarding claim 18, Lach discloses a deformation state in page 4, lines 1-4.

Regarding claim 20, Lach discloses a light beam (light beam FI, see page 4, lines 2-3 and Fig. 2).

Regarding claim 21, discloses the transmitter 2 and receiver 3 are mounted in combination with the body 1 which elastically deformable, see: page 3, lines 19-21.

Regarding claims 22-24, Lach shows reflector 8 in Fig. 5.

Regarding claim 26, Lach discloses transmitter 2 transmits a light beam, see: page 3, lines 23-24 and 28-34.

Regarding claims 27-28, Lach discloses a flexible housing (spring 7 shown in Fig. 4).

Regarding claim 31, Figs 1, 3, 5 show transmitter 2 and receiver 3 with rectangular shapes.

Regarding claim 33, Lach shows in Fig. 6 the housing in form of a drill bore in the component.

Regarding claim 34, Lach discloses the receiver is associated with an evaluation logic (receiver 3 is associated with circuit detection 5 to determine the deformation of the component, see: page 4, lines 13-15).

Regarding claim 35, Lach shows in Fig. 4 transmitter 2 in a box or holder and receiver 3 in a box or holder. Fig. 5 also shows a reflector (8) disposed at a distance

Art Unit: 2856

from the transmitter in a second holder, and the transmitter, receiver, and reflector are disposed on the component in a shared housing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latch (French Patent 2,578,974).

Regarding claims 30 and 32, they differ from Latch by reciting the transmitter and the receiver have a round shape and the housing has round shape. It would have been an obvious matter of design choice to modify Latch to provide transmitter, receiver and housing in a round shape, since applicant has not disclosed that the round shape solves

Art Unit: 2856

any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the rectangular shape.

7. Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latch (French Patent 2,578,974) in view of Batie et al. (US Patent 4,222,262).

Claims 19 and 25 differ from Latch by reciting the receiver includes a transducer and wherein the light-sensitive surface of the receiver has a resolution of 1000d. Battie discloses photodiodes have the ability to detect low levels of light intensity can be used in hardness testing apparatus, see: col. 2, lines 44-54. It would have been obvious to one having ordinary skill in the art at the time of the invention to utilize in Latch the techniques of Batie because such photodiodes used in the photosensitive detection means are located with their light-sensitive surfaces in the image plane of a microscope objective lens which microscope forms part of imaging means of the device thereby, making the above combination more effective. Furthermore, with regard to the resolution of 1000d, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques M Saint-Surin whose telephone number is (703) 308-3698. The examiner can normally be reached on Monday-Friday.

Art Unit: 2856

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (703) 305-4705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.


Jacques M. Saint-Surin
April 7, 2003


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800